ORDER OF SEPTEMBER 23, 1974

BY THE UNITED STATES COURT OF APPEALS
FOR THE DISTRICT OF COLUMBIA CIRCUIT

Before: Leventhal and MacKinnon, Circuit Judges

On consideration of appellant's motion for summary reversal, the opposition thereto, and of appellant's motion for reconsideration of this Court's order of May 22, 1974, it is

ORDERED by the Court that appellant's aforesaid motion for summary reversal is denied, and, it is

FURTHER ORDERED by the Court that the time for filing appellant's brief is extended for a period of 15 days from the date of this order.

Per Curiam

ORDER OF OCTOBER 18, 1974

BY THE UNITED STATES COURT OF APPEALS
FOR THE DISTRICT OF COLUMBIA CIRCUIT

Before: Bazelon, Chief Judge, Wright, McGowan, Tamm, Leventhal, Robinson, MacKinnon, Robb and Wilkey, Circuit Judges

On consideration of the petition for rehearing, *en banc*, of appellant's motion for summary reversal and no judge of the Court in regular active service having called for a vote thereon, it is

ORDERED by the Court, *en banc*, that appellant's aforesaid suggestion is denied.

Per Curiam

MEMORANDUM-ORDER

ENTERED JANUARY 10, 1974
BY THE UNITED STATES DISTRICT COURT
FOR THE DISTRICT OF COLUMBIA

This matter came before the Court upon remand from the Court of Appeals to consider plaintiff's request for indices of manuscript decisions and to further examine matters relating to the original complaint.[1]

Originally, this Court entered an Order on October 26, 1970, granting defendant's motion to dismiss the complaint,[2] except insofar as this Court ordered the Patent Office to create and maintain an index of current unpublished manuscript decisions.[3] Plaintiff had requested "all unpublished manuscript decisions together with such indices as are available." This Court rejected that request as too broad to be "identifiable records" within the meaning of 5 U.S.C. § 552(a)(3), and, accordingly, denied the request. Because it appeared that plaintiff would be unable to formulate a request of the necessary specificity without some sort of index being available, the Order required the Patent Office to create and maintain a current index under 5 U.S.C. § 552(a)(2).

On appeal, plaintiff renewed his claim as to both the manuscript decisions and the indices. The Court of Ap-

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[1] "Construing the request for indices as separate from the request for all manuscript decisions, we think appellant is entitled to a remand for consideration and disposition of this part of the case . . . . We of course leave open the question whether the remand . . . might lead to further light on the request for manuscript decisions themselves, not excluding the possibility of such amendment to the complaint as the District Court may permit in the exercise of a sound discretion . . . ."

465 F.2d 608, 613-14 (D.C. Cir. 1972).

[2] 321 F. Supp. 628 (D.D.C. 1970).

[3] *Id.* at 629.

peals affirmed the dismissal of the complaint as to the request for all manuscript decisions,[4] but left open for reconsideration on remand the question of available indices and also the possibility that an amended complaint could be framed to make the records request acceptable.[5]

The Court held an oral hearing May 10, 1973, and received detailed memoranda from each side exploring the question of the available indices. In addition, plaintiff has sought to file an amended and a second amended complaint, and numerous other motions have been made.

I. The Indices.

The indices plaintiff seeks fall into three categories. The first involves a series of bound volumes collecting manuscript decisions from 1853 to 1954. There are 175 volumes in the series, in which manuscript decisions are chronologically arranged.[6] Bound into the front of volumes 1 through 144 is an alphabetical index consisting of 26 pages, one page for each letter of the alphabet.[7] On each page is listed the name in which the patent application was filed, and the page number at which the decision in that application appears. Because the volumes are of folio size and each consists of three to four hundred pages, and because most manuscript decisions are one page or less, each volume contains a large number of decisions.

If these indices were to be made available, the Patent Office would have to copy them via a photographic repro-

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[4] 465 F.2d 608, 613, 614 (D.C. Cir. 1972).

[5] *Id.* at 613-15.

[6] Affidavit of Raymond E. Martin, Associate Solicitor of the United States Patent Office at 2 (June 2, 1970).

[7] Information for this further description is based upon inspection of the Patent Office records warehouse November 30, 1973, by this Court's staff.

duction method. It is estimated that two man-days and an expenditure of $300 would be required to reproduce the approximately 3,744 pages in question.

The Court feels that these indices should be made available. Without the aid of some sort of index, plaintiff will forever be unable to formulate with specificity a request for manuscript decisions that would permit the Patent Office to produce the material desired. The current index being maintained by the Patent Office pursuant to the Court's Order of October 26, 1970, includes only decisions from July 4, 1967, forward.[8] This Court is clearly without authority to order the creation of an index for any material prior to that date,[9] but it is possible to order the reproduction of existing indices insofar as they are "identifiable records" that may be requested under 5 U.S.C. § 552(a)(3).

The Patent Office has raised some objections to the reproduction and release of these indices. In short, it contends that 35 U.S.C. § 122 (confidential status of patent applications) requires the Patent Office to refrain from giving out any information about patent applications. Because abandoned applications are considered to be covered by this section,[10] the Patent Office argues that to release an index to manuscript decisions bound in a volume containing decisions in both abandoned as well as granted patent applications is to violate 35 U.S.C. § 122, because giving out the name of the applicant (as listed in the index) is giving out "information." The Court finds this argument of insufficient merit to prevent the release of the indices.

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[8] 321 F. Supp. at 629.

[9] The Freedom of Information Act only provides for a current index. 5 U.S.C. § 552(a)(2). *See* Davis, Administrative Law Treatise, § 3A.14 (1970 Supp).

[10] *See* United States Department of Commerce, Patent Office, Rules of Practice 14(b) (January 1970).

35 U.S.C. § 122 states:

> Applications for patents shall be kept in confidence by the Patent Office and no information concerning the same given without authority of the applicant or owner unless necessary to carry out the provisions of any Act of Congress or in such special circumstances as may be determined by the Commissioner.

The Freedom of Information Act was designed to "establish a general philosophy of full agency disclosure unless information is exempted under clearly delineated statutory language . . . ."[11] The statutory language of 35 U.S.C. § 122 does not clearly delineate what "no information" means. It strains reason, however, to say the release of the name of an applicant is conclusively barred when Section 122 also states that "information" may be released if "necessary to carry out the provisions of any Act of Congress. . . . " 5 U.S.C. is such an Act.

Case law has recognized that Section 122 does not throw an impenetrable cloak of secrecy around all aspects of patent applications. Although in the context of patent interference litigation rather than a Freedom of Information Act case, courts have uniformly held that disclosure of confidential files must be made where justice requires.[12] Because Section 122 cannot be grounds for maintaining secrecy when it would be unreasonable to have such

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[11] S. Rep. No. 813, 89th Cong., 1st Sess. 3 (1965). "A democratic society requires an informed, intelligent electorate, and the intelligence of the electorate varies as the quantity and quality of its information varies." H. Rep. No. 1497, 89th Cong., 2d Sess. 12 (1966).

[12] *See, e.g., James B. Clow & Sons, Inc.* v. *United States Pipe and Foundry Co.*, 313 F.2d 46, 51 (5th Cir. 1963); *Struthers Scientific & Int'l Corp.* v. *General Foods Corp.*, 45 F.R.D. 375, 381 (S.D. Texas 1968); *Britt Tech. Corp.* v. *L. & A. Products, Inc.*, 223 F. Supp. 126 (D. Minn. 1963); *Cardex Corp.* v. *Olin Mathieson Chemical Corp.*, 23 F.R.D. 27, 31 (S.D. Ill. 1958); *Great Lakes Carbon Corp.* v. *Continental Oil Co.*, 23 F.R.D. 33 (W.D. La. 1958).

secrecy, it cannot bar the revelation of applicants' names in the indices in question.[13] Further, the most recent of the manuscript decisions involved is 1923. The intervening fifty years reduces significantly the possibility that any prejudice could result from the revelation of an applicant's name in this index.

The Patent Office further argues that the recent decision by Judge Oren Lewis in *Sears* v. *Gottschalk*, 357 F. Supp. 1327 (E.D. Va. 1973), *appeal docketed*, No. 73-1699, 4th Cir., June 13, 1973, supports its position that the indices cannot be released under 35 U.S.C. § 122. The demand made in that case was for "all existing abandoned United States patent applications."[14] Judge Lewis held that abandoned applications, maintained in secrecy pursuant to Section 122 and Patent Office rules,[15] are exempted under 5 U.S.C. § 552(b)(3), the prior statute exemption.[16] This Court is in agreement with Judge Lewis' ruling, but feels it does not support the Patent Office's position insofar as these indices are concerned. There is a vast difference between a broad, sweeping request for the entire contents of all abandoned patent applications and the release of a 70-year compilation of indices containing only the bare name of the applicant.

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[13] Of course, the Patent Office may at its option review these indices with an eye toward blocking out the names of any and all applicants who have not been granted a patent. The Court recognizes, however, that a tremendous number of man-hours would be required to perform this task, and does not feel that such editing is necessary to comply with Section 122.

[14] *Sears* v. *Gottschalk*, 357 F. Supp. 1327 (E.D. V. 1973), *appeal docketed*, No. 73-1699, 4th Cir., June 13, 1973.

[15] See note 10, *supra*, and accompanying text.

[16] *Sears* v. *Gottschalk*, *supra*, at 1329-30.

II. Further indices.

Plaintiff claims that further indices exist and should be released. The claimed indices are "docket cards" and "file wrapper jackets." The former is a master card for recording each and every event in the course of processing a patent application; the latter serves a similar function, but is at the same time attached to the front of the applications file. Neither the cards nor the jackets are collected in any way that would serve a regular index function within the Patent Office, and they contain considerably more information about individual applications than do the indices discussed in Part I.

This sort of material is not a true index, and cannot be considered as such for the use of plaintiff. Further, because each contains considerably more information about the application, including an indication of the type of invention involved, these items fall into the group of materials protected by 35 U.S.C. § 122 and the rulings of *Misegades & Douglas* v. *Schuyler*, 328 F. Supp. 619 (E.D. Va. 1971), and *Sears* v. *Gottschalk*, 357 F. Supp. 1327 (E.D. Va. 1973). Accordingly, docket cards and file wrapper jackets will not be made available to plaintiff as an index.

III. Amended Complaint.

Plaintiff has submitted motions for leave to file an amended, and later, a second amended complaint. That latter proposed complaint evidently represents a further adjustment of the complaint to conform with the facts of the case and with the spirit of the Court of Appeals' recommendation that further consideration in this Court may lead to "the possibility of such amendment of the complaint as the District Court may permit in the exercise of a sound discretion. . . ." 465 F.2d 608, 614 (D.C. Cir. 1972).

Where a motion to dismiss the complaint has been granted and sustained, as is the case here, the trial court has discretion to permit amendment of the complaint only where the order of the Court of Appeals specifically provides for such action.[17] Because that is the case here, this Court must consider whether or not the amended complaint will cure the defects of the original one.[18] In this case, it must be said that it will not. Additional relief is already being granted to the extent that certain existing indices will be made available. As to the remainder of additional relief demanded by plaintiff, the Court, in the exercise of its discretion, denies leave to file either the amended or second amended complaint. Even so, virtually every form of relief requested by plaintiff in the second amended complaint is before the Court in the form of separate motions. For instance, on June 19, 1973, plaintiff moved for partial summary judgment under Fed. R. Civ. P. 56 and 54(c), seeking an order requiring the Patent Office to produce (1) the "170 to 175 volumes" of manuscript decisions covering the years 1853-1954, and (2) any and all indices that may exist in the files of the Patent Office, including the indices to the bound volumes, the individual docket cards, and the file wrapper jacket. The only additional items sought by the proposed second amended complaint are (1) all manuscript decisions from 1955 to the present and any unbound decisions prior to 1955, (2) an order forbidding the Patent Office from continuing its periodic destruction of old abandoned patent applications, and (3) an order requiring the Patent Office to comply fully with this Court's Order of October 26, 1970.

The first of these three issues, the demand for all manuscript decisions not included in the 175 bound

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[17] *Ginsberg* v. *Stern*, 242 F.2d 379 (3rd Cir. 1957); *United States* v. *Newberry Mfg. Co.*, 123 F.2d 453 (1st Cir. 1941).

[18] *See Kirsch* v. *Barnes*, 157 F. Supp. 671 (N.D. Cal. 1957).

volumes, is clearly the same type of broad, sweeping and indiscriminate request originally denied by this Court October 26, 1970, and sustained by the Court of Appeals June 15, 1972. No such amendment will be allowed.

The second and third of these three issues raised in the proposed second amended complaint that are not found in the motion for partial summary judgment are before this Court by way of separate motions submitted by the plaintiff. Specifically, on June 11, 1973, plaintiff moved for a "rule to show cause why defendant should not be held in contempt for willful obstruction of justice," referring to the destruction of certain docket cards. Because docket cards have already been considered and rejected as an "available index" pursuant to the remand from the Court of Appeals,[19] this motion will be denied, and the Patent Office may continue routine destruction of agency records.[20] Also, on June 11, plaintiff moved this Court for a "rule to show cause pursuant to 5 U.S.C. § 552(a)(3) and Fed. R. Civ. P. 70 why defendant should not be held in contempt for failure to comply with October 26, 1970 Order." This motion will be considered below.[21]

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[19] *See* Part II.

[20] The proposed second amended complaint also complains of the destruction of manuscript decisions. It is evidently the policy of the Patent Office to consider abandoned applications eligible for destruction after twenty years, and presumably manuscript decisions contained therein would also be destroyed. *See* United States Department of Commerce, Patent Office, Rules of Practice 14(b) (January 1970). Because plaintiff's broad request for all manuscript decisions was denied by the Court, affirmed on appeal, it would not be appropriate to consider such routine agency destruction of old manuscript decisions. However, any manuscript decisions contained in the bound volumes 1-144 to which an index will be made available, and any manuscript decisions indexed under this Court's Order of October 26, 1970, may not be destroyed.

[21] See Part V, *infra*.

Thus it is apparent that despite denying leave to file an amended complaint, the Court is giving consideration to every issue reasonably raised therein through consideration of the two motions of June 11, 1973, and the motion for partial summary judgment of June 19, 1973.

IV. Summary Judgment.

As previously noted, on June 19, 1973, plaintiff moved the Court for partial summary judgment, seeking the 175 bound volumes of manuscript decisions compiled from 1853 to 1954, and any and all indices to manuscript decisions. The latter portion of the request has already been dealt with extensively pursuant to the Court of Appeals' remand and will not be repeated here.[22]

Asking for 175 bound folio volumes of manuscript decisions does somewhat narrow plaintiff's original request, but still lacks requisite specificity. Each volume contains hundreds of decisions, thus making the compilation one of about 100,000 decisions. The question of whether or not this is a request for "identifiable records" within the meaning of *Bristol-Myers Co.* v. *F.T.C.*, 424 F.2d 935 (D.C. Cir. 1970), and *American Mail Line, Ltd.* v. *Gulick*, 411 F.2d 696 (D.C. Cir. 1969), need not be decided here, however, for another consideration takes precedence. Because a manuscript decision in a patent application is protected as being a portion of that file,[23] release of the bound volume *in toto* would mean release of manuscript decisions in pending and abandoned applications as well as granted ones—and the former have a confidential status that is protected by Section 122.[24]

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[22] See Parts I and II, *supra*.

[23] *Cf. Misegades & Douglas* v. *Schuyler*, 328 F. Supp. 619 (E.D. Va. 1971), *appeal dismissed* 456 F.2d 255 (4th Cir. 1972).

[24] The Court recognizes that very few of the manuscript decisions in question would be in still-pending applications, but is also mindful that abandoned applications have been held to enjoy that same

By ordering the release of the indices to all those volumes which are presently indexed, i.e., volumes 1-144, the Court is making available to plaintiff a means for formulating a more specific request. If a requested manuscript decision is available to the public, the Patent Office will be able to produce the volume containing that decision and thereby make the decision available.[25] If a requested decision is not available because the application was never granted, the Patent Office will so inform the one making the request. In this way plaintiff and all others will be assured a means of access to all those bound decisions from 1853 to 1923 which can be made available under Section 122. Accordingly, that portion of plaintiff's motion for summary judgment which requests all 175 bound volumes will be denied.

V. Contempt Motion

Plaintiff moves to hold defendant in contempt of Court for failure to fully comply with the October 26, 1970, Order requiring that

> the United States Patent Office maintain and make available for public inspection and copying a current index providing identifying information for the public as to the unpublished manuscript decisions of the Patent Office since July 4, 1967, insofar as the same is required by 5 U.S.C. § 552(a)(2).

321 F. Supp. at 629.

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secrecy. *Sears* v. *Gottschalk*, 357 F. Supp. 1327 (E.D. Va. 1973), *appeal docketed*, No. 73-1699, 4th Cir., June 13, 1973.

[25] The Patent Office has objected to this procedure on the grounds that if it must produce a volume containing a requested decision, the person requesting the decision would then be able to see decisions in that same volume held in confidentiality under Section 122. The Court feels that by either reproducing and making available a copy of the requested decision or by monitoring the requester as he reads and/or copies the requested decision, any such feared breach of confidentiality can easily be avoided. There is little likelihood that the volume of requests would be such as to seriously inconvenience the Patent Office.

Plaintiff makes no allegation that the Patent Office is not satisfactorily indexing its manuscript decisions, but rather raises questions as to material referred to in 5 U.S.C. § 552(a)(2)(B) and (C), that is, statements of policy not published in the Federal Register, staff manuals and instructions to staff affecting the public. The Court notes that these items were never requested in plaintiff's original complaint, and as a result, they were not incorporated into the Order of October 26, 1970. Because that Order has been affirmed and this case is on remand for limited purposes only, the issue of whether or not the Patent Office is fully indexing Section 552 (a)(2)(B) and (C) material is not properly before the Court.

Upon inspection of the indices being maintained, the Court finds full compliance with the October 1970 Order. The Patent Office has compiled five indices which comprehensively cover Board of Appeals decisions, Board of Patent Interference decisions, and Commissioner's decisions. For the first group, two indices are maintained: one consists of decisions in granted applications, i.e., those generally available to the public. This index lists the patent application number, and classifies the decisions into 36 categories, with cross-references to other applicable categories. Determining the nature of the categories is a simple exercise. The second Board of Appeals index is one compiling all other decisions under coded appeals numbers, and thus indexes both unavailable decisions (pending, denied or abandoned applications) and very recently available decisions (those which have matured into patents after the entry of the decisions indexed and before the next updating of the "public" index). This latter index is also available to the public, and upon request the Patent Office will research the file of a particular application to see whether or not it can be

publicly released. The two indices are both updated quarterly.

Board Of Patent Interference decisions are treated in two indices, in a like fashion to Board of Appeals decisions, but one not updated on a regular basis.[26] These indices of decisions are also classified in 36 categories, but are not cross-referenced in the manner of the Board of Appeals decisions. Both are available to the public on the same terms as the Board of Appeals indices.

Commissioner's decisions have been one index, covering both available and protected decisions, compiled by a system of code numbers. Due to their particular scope and function,[27] very few of these decisions would ever be available to the public. Therefore, when a request for one is made, the Patent Office will research its files to see if release would be permissible. The Court has also gone on to investigate 5 U.S.C. § 552(a)(2)(B) and (C) material, and found that there are apparently no statements of policy, staff manuals or staff instructions that are not already available to the public. Accordingly, the Court overrules this motion.

VI. Conclusion

The Court has carefully considered all matters brought to its attention by both the remand from the Court of Appeals and the various motions and memoranda filed by the parties, and accordingly, it is by the Court this 10th day of January, 1974,

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[26] There are many fewer such decisions, and quarterly up-dating is highly wasteful in terms of computer operation time; accordingly, the Patent Office has no regular schedule for up-dating these indices, but anticipates roughly annual review.

[27] United States Department of Commerce, Patent Office, Rules of Practice 113 and 181 (January 1970).

ORDERED that each index bound in the front of volumes 1-144 be reproduced and made available in order to aid plaintiff in formulating more specific requests for identifiable records under 5 U.S.C. § 552(a)(3); and it is further

ORDERED that plaintiff's motion for partial summary judgment be granted only insofar as the indices of bound volumes 1-144 are concerned; and it is further

ORDERED that the remaining portions of plaintiff's motion for partial summary judgment be denied; and it is further

ORDERED that plaintiff's motion for leave to file a second amended complaint be denied; and it is further

ORDERED that plaintiff's contempt motion as regards routine destruction of agency records be denied; and it is further

ORDERED that plaintiff's contempt motion for failure to comply with this Court's Order of October 26, 1970, be denied; and it is further

ORDERED that plaintiff's motion to reconsider granting defendants' motion to quash subpoena on Raymond Martin (Order of May 7, 1973) be denied as moot.

/s/ Oliver Gasch, Judge

MEMORANDUM ORDER

ENTERED MARCH 11, 1974
BY THE UNITED STATES DISTRICT COURT FOR THE
DISTRICT OF COLUMBIA

This matter comes before the Court upon plaintiff's motion to vacate the Court's Memorandum-Order of January 10, 1974, to recuse the district judge and to reopen proceedings. Only the second of these points, the requested recusal, necessitates consideration.

This action was filed under the Freedom of Information Act against the Commissioner of Patents in 1970, seeking access to all past manuscript decisions of the Patent Office. On October 26, 1970, this Court granted defendant's motion to dismiss for lack of a sufficiently specific request, except insofar as the defendant was ordered to maintain a current index of manuscript decisions to aid plaintiff in formulating more specific requests. Plaintiff appealed. The United States Court of Appeals sustained the dismissal, but remanded for exploration of existing indices that would aid plaintiff in stating a request; the Court of Appeals also indicated that such exploration "might lead to further light on the request for manuscript decisions themselves, not excluding the possibility of such amendment to the complaint as the District Court may permit in the exercise of a sound discretion . . . . 151 U.S.App.D.C. 23 ,29, 465 F.2d 608, 614.

After a hearing and after consideration of lengthy memoranda submitted by both parties, this Court issued the Memorandum-Order in question, which denied leave for plaintiff to file his second amended complaint on the grounds that the proposed complaint was still lacking in the necessary specificity under 5 U.S.C. § 552 (a)(3). However, the Court dealt with virtually every

issue raised in the proposed complaint through consideration of several additional motions filed by plaintiff. Some further relief was granted, that is, the release of certain existing indices which may aid plaintiff in formulating requests of the necessary specificity.

In considering the many questions raised by plaintiff upon remand, the Court deemed it advisable to gain a better perspective on the materials actually in issue. To this end, a member of this Court's staff viewed the Patent Office warehouse November 30, 1973, to see exactly what bound volumes of manuscript decisions were in existence and to examine the indices attached thereto. At the same time, the Court also sought to ascertain the nature of the indices being maintained by the Patent Office under the Memorandum-Order of October 26, 1970. This effort by the Court to more accurately ascertain what lay at the root of this action was not hidden from the plaintiff, as it was fully acknowledged in the Memorandum-Order of January 10, 1974, footnote 7.

The conduct of the Court in all litigation should be focused on securing "the just, speedy, and inexpensive determination of every action." Fed. R. Civ. P. 1. It was to this end that a physical inspection of the manuscript decisions and indices was made. An *in camera* inspection would have required the transfer of numerous bulky and heavy items to the Court House, clearly a burden on both the Patent Office and this Court. The method chosen was to send a member of this Court's staff to the Patent Office to report on the physical existence and makeup of these items. Both judicial economy and economy of the parties was served.

Plaintiff has made many varied allegations in support of the motion for recusal. First, plaintiff assumes that at least two separate visits were made; in fact, the only visit was that of November 30, 1973, fully identified by the Court in the Memorandum-Order. Further,

plaintiff objects to the characterization of the bound volumes inspected as being a "compilation . . . of about 100,000 decisions" as not having previously appeared in the record. It is a simple exercise to note the average length of manuscript decisions and the number of pages in an average volume in order to reach the conclusion that 175 volumes contain approximately that number of decisions. Plaintiff himself indicated in open Court that the number of unpublished manuscript decisions is "[m]any thousands I am quite sure." The Court can see no prejudice in this finding.

Plaintiff objects to the Court's characterization that "[i]t is estimated that two man-days and an expenditure of $300 would be required to reproduce the approximately 3,744 pages in question." It is difficult to understand plaintiff's objection to this finding, inasmuch as the Court ordered those indices reproduced. Nor does it indicate a damaging *ex parte* presentation of the Patent Office, as it is a simple exercise for anyone vaguely familiar with photocopy techniques to make a rough estimate of the time and expense involved in the reproduction of 3,744 folio pages.

Plaintiff has also pointed to the Court's staff inspection of the indices being maintained by the Patent Office pursuant to the Memorandum-Order of October 26, 1970, as further evidence of *ex parte* conduct. It should be noted that in the Order of January 10, 1974, the Court found that "[p]laintiff makes no allegation that the Patent Office is not satisfactorily indexing its manuscript decisions . . . ," and that the contempt motion under consideration was "not properly before the Court." However, because this litigation has centered around the need for indices from which plaintiff and other members of the public could make a request of the necessary specificity of the Patent Office, the Court deemed it wise to inspect the indices, which are available to the public, to asertain whether there has been full compliance with

this Court's Order of October 26, 1970. This inspection, like that of the records warehouse, was a physical identification of material.

Plaintiff also would appear to be accusing the United States Attorney of filing a false sworn answer to his interrogatory no. 14. That highly unusual interrogatory read:

> Has defendant or any one acting on defendants' behalf, including a member of the U.S. Attorney's staff, been in contact with anyone from Judge Gasch's office or staff, including Judge Gasch, in regard to any aspect of this case, including the timing of future proceedings herein at any time since May 10, 1973?
>
> If the answer to this interrogatory is anything other than an unqualified no, (a) Describe fully each contact including without limitation as a part of the answer the names and addresses of all persons involved, the date, time and circumstances of the meeting including how it came about, the substance of what was said by each involved person and an identification of any and all pertinent documents that may exist.

Michael J. Ryan, Assistant United States Attorney, answered November 15, 1973:

> Interrogatory 14 is highly objectionable as being irrelevant, improper and scandalous, in that it impugns the integrity of both the Court and counsel. The answer, however, is an unequivocal no.

Plaintiff accuses the United States Attorney of a false answer by assuming that an inspection by the Court's staff November 30, 1973, meant that there must have been some contact prior to November 15, 1973. In fact, plaintiff's assumption is wrong, and the answer of the United States Attorney was not, as plaintiff claims, a false one.

Plaintiff objects to this Court's characterization of docket cards and file wrapper jackets as not being meaningful indices, claiming that no support for the Court's finding is in the record. That is not the case. Information supporting this finding can be found in defendant's Memorandum After Oral Hearing on Plaintiff's Motion for Leave to File Amended Complaint at 3-13.

Plaintiff relies on the case *In Re Murchison*, 349 U.S. 133 (1955), wherein the Supreme Court found that a judge who had conducted a secret "one man grand jury" in a contempt proceeding could not preside at the ensuing trial of the same matter. The Court's action in making a staff inspection of the manuscript decisions and the indices being maintained pursuant to this Court's prior Order is vastly different. This litigation has been long and difficult. Many motions have been considered, it has been heard by the Court of Appeals and again by this Court on remand. An extensive record exists. The Court, in its effort to reach a just and expeditious conclusion to the matter, made a physical inspection of certain items to assure that the relief granted January 10, 1974, (release of the indices to bound manuscript decisions) was both physically possible and meaningful to plaintiff. The Court finds no element of prejudice to the plaintiff in the action of November 30, 1973.

Accordingly, it is by the Court this 11th day of March, 1974,

ORDERED that plaintiff's motion to vacate the Memorandum-Order of January 10, 1974, to recuse and to reopen proceedings be and the same is hereby denied.

/s/ Oliver Gasch
Judge

CODE OF JUDICIAL CONDUCT

CANON 2

A Judge Should Avoid Impropriety and the Appearance of Impropriety in All His Activities

A. A judge should respect and comply with the law and should conduct himself at all times in a manner that promotes public confidence in the integrity and impartiality of the judiciary.

B. A judge should not allow his family, social, or other relationships to influence his judicial conduct or judgment. He should not lend the prestige of his office to advance the private interests of others; nor should he convey or permit others to convey the impression that they are in a special position to influence him. He should not testify voluntarily as a character witness.

Commentary: Public confidence in the judiciary is eroded by irresponsible or improper conduct by judges. A judge must avoid all impropriety and appearance of impropriety. He must expect to be the subject of constant public scrutiny. He must therefore accept restrictions on his conduct that might be viewed as burdensome by the ordinary citizen and should do so freely and willingly.

The testimony of a judge as a character witness injects the prestige of his office into the proceeding in which he testifies and may be misunderstood to be an official testimonial. This Canon, however, does not afford him a privilege against testifying in response to an official summons.

CANON 3

A Judge Should Perform the Duties of His Office Impartially and Diligently

The judicial duties of a judge take precedence over all his other activities. His judicial duties include all the duties of his office prescribed by law. In the performance of these duties, the following standards apply:

A. ADJUDICATIVE RESPONSIBILITIES.

(1) A judge should be faithful to the law and maintain professional competence in it. He should be unswayed by partisan interests, public clamor, or fear of criticism.

(2) A judge should maintain order and decorum in proceedings before him.

(3) A judge should be patient, dignified, and courteous to litigants, jurors, witnesses, lawyers, and others with whom he deals in his official capacity, and should require similar conduct of lawyers, and of his staff, court officials, and others subject to his direction and control.

Commentary: The duty to hear all proceedings fairly and with patience is not inconsistent with the duty to dispose promptly of the business of the court. Courts can be efficient and business-like while being patient and deliberate.

(4) A judge should accord to every person who is legally interested in a proceeding, or his lawyer, full right to be heard according to law, and, except as authorized by law, neither initiate nor consider *ex parte* or other communications concerning a pending or impending proceeding. A judge, however, may obtain the advice of a disinterested expert on the law applicable to a proceed-

ing before him if he gives notice to the parties of the person consulted and the substance of the advice, and affords the parties reasonable opportunity to respond.

Commentary: The proscription against communications concerning a proceeding includes communications from lawyers, law teachers, and other persons who are not participants in the proceeding, except to the limited extent permitted. It does not preclude a judge from consulting with other judges, or with court personnel whose function is to aid the judge in carrying out his adjudicative responsibilities.

An appropriate and often desirable procedure for a court to obtain the advice of a disinterested expert on legal issues is to invite him to file a brief *amicus curiae.*

(5) A judge should dispose promptly of the business of the court.

Commentary: Prompt disposition of the court's business requires a judge to devote adequate time to his duties, to be punctual in attending court and expeditious in determining matters under submission, and to insist that court officials, litigants and their lawyers cooperate with him to that end.

(6) A judge should abstain from public comment about a pending or impending proceeding in any court, and should require similar abstention on the part of court personnel subject to his direction and control. This subsection does not prohibit judges from making public statements in the course of their official duties or from explaining for public information the procedures of the court.

Commentary: "Court personnel" does not include the lawyers in a proceeding before a judge. The conduct of lawyers is governed by DR7-107 of the *Code of Professional Responsibility.*

(7) A judge should prohibit broadcasting, televising, recording, or taking photographs in the courtroom and areas immediately adjacent thereto during sessions of court or recesses between sessions, except that a judge may authorize:

(a) the use of electronic or photographic means for the presentation of evidence, for the perpetuation of a record, or for other purposes of judicial administration;

(b) the broadcasting, televising, recording, or photographing of investitive, ceremonial, or naturalization proceedings;

(c) the photographic or electronic recordings and reproduction of appropriate court proceedings under the following conditions:

(i) the means of recording will not distract participants or impair the dignity of the proceedings;

(ii) the parties have consented, and the consent to being depicted or recorded has been obtained from each witness appearing in the recording and reproduction;

(iii) the reproduction will not be exhibited until after the proceeding has been concluded and all direct appeals have been exhausted; and

(iv) the reproduction will be exhibited only for instructional purposes in educational institutions.

Commentary: Temperate conduct of judicial proceedings is essential to the fair administration of justice. The recording and reproduction of a proceeding should not distor or dramatize the proceeding.

B. ADMINISTRATIVE RESPONSIBILITIES

(1) A judge should diligently discharge his administrative responsibilities, maintain professional competence

in judicial administration, and facilitate the performance of the administrative responsibilities of other judges and court officials.

(2) A judge should require his staff and court officials subject to his direction and control to observe the standdards of fidelity and diligence that apply to him.

(3) A judge should take or initiate appropriate disciplinary measures against a judge or lawyer for unproffessional conduct of which the judge may become aware.

Commentary: Disciplinary measures may include reporting a lawyer's misconduct to an appropriate disciplinary body.

(4) A judge should not make unnecessary appointments. He should exercise his power of appointment only on the basis of merit, avoiding nepotism and favoritism. He should not approve compensation of appointees beyond the fair value of services rendered.

Commentary: Appointees of the judge include officials such as referees, commissioners, special masters, receivers, guardians and personnel such as clerks, secretaries, and bailiff. Consent by the parties to an appointment or an award of compensation does not relieve the judge of the obligation prescribed by this subsection.

C. DISQUALIFICATION.

(1) A judge should disqualify himself in a proceeding in which his impartiality might reasonably be questioned, including but not limited to instances where:

(a) he has a personal bias or prejudice concerning a party, or personal knowledge of disputed evidentiary facts concerning the proceeding;

(b) he served as lawyer in the matter in controversy, or a lawyer with whom he previously practiced law

served during such association as a lawyer concerning the matter, or the judge or such lawyer has been a material witness concerning it;

Commentary: A lawyer in a governmental agency does not necessarily have an association with other lawyers employed by that agency within the meaning of this subsection; a judge formerly employed by a governmental agency, however, should disqualify himself in a proceeding if his impartiality might reasonably be questioned because of such association.

(c) he knows that he, individually or as a fiduciary, or his spouse or minor child residing in his household, has a financial interest in the subject matter in controversy or in a party to the proceeding, or any other interest that could be substantially affected by the outcome of the proceeding;

(d) he or his spouse, or a person within the third degree of relationship to either of them, or the spouse of such a person:

(i) is a party to the proceeding, or an officer, director, or trustee of a party;

(ii) is acting as a lawyer in the proceeding;

Commentary: The fact that a lawyer in a proceeding is affiliated with a law firm with which a lawyer-relative of the judge is affiliated does not of itself disqualify the judge. Under appropriate circumstances, the fact that "his impartiality might reasonably be questioned" under Canon 3(C)(1), or that the lawyer-relative is known by the judge to have an interest in the law firm that could be "substantially affected by the outcome of the proceeding" under Canon 3(C)(1)(d)(iii) may require his disqualification.

(iii) is known by the judge to have an interest that could be substantially affected by the outcome of the proceeding;

(iv) is to the judge's knowledge likely to be a material witness in the proceeding;

(2) A judge should inform himself about his personal and fiduciary financial interests, and make a reasonable effort to inform himself about the personal financial interests of his spouse and minor children residing in his household.

(3) For the purposes of this section:

(a) the degree of relationship is calculated according to the civil law system;

Commentary: According to the civil law system, the third degree of relationship test would, for example, disqualify the judge if his or his spouse's father, grandfather, uncle, brother, or niece's husband were a party or lawyer in the proceeding, but would not disqualify him if a cousin were a party or lawyer in the proceeding.

(b) "fiduciary" includes such relationships as executor, administrator, trustee, and guardian;

(c) "financial interest" means ownership of a legal or equitable interest, however small, or a relationship as director, advisor, or other active participant in the affairs of a party, except that:

(i) ownership in a mutual or common investment fund that holds securities is not a "financial interest" in such securities unless the judge participates in the management of the fund;

(ii) an office in an educational, religious, charitable, fraternal, or civic organization is not a "financial interest" in securities held by the organization;

(iii) the proprietary interest of a policy holder in a mutual insurance company, of a depositor in a mutual savings association, or a similar proprietary interest, is a "financial interest" in the organization only if the out-

come of the proceeding could substantially affect the value of the interest;

(iv) ownership of government securities is a "financial interest" in the issuer only if the outcome of the proceeding could substantially affect the value of the securities.

D. REMITTAL OF DISQUALIFICATION.

A judge disqualified by the terms of Canon 3C(1)(c) or Canon 3C(1)(d) may, instead of withdrawing from the proceeding, disclose on the record the basis of his disqualification. If, based on such disclosure, the parties and lawyers, independently of the judge's participation all agree in writing that the judge's relationship is immaterial or that his financial interest is insubstantial, the judge is no longer disqualified, and may participate in the proceeding. The agreement, signed by all parties and lawyers, shall be incorporated in the record of the proceeding.

Commentary: This procedure is designed to minimize the chance that a party or lawyer will feel coerced into an agreement. When a party is not immediately available, the judge without violating this section may proceed on the written assurance of the lawyer that his party's consent will be subsequently filed.

5 U.S.C. 552

§ 552. Public information; agency rules, opinions, orders, records, and proceedings

(a) Each agency shall make available to the public information as follows:

(1) Each agency shall separately state and currently publish in the Federal Register for the guidance of the public—

(A) descriptions of its central and field organization and the established places at which, the employees (and in the case of a uniformed service, the members) from whom, and the methods whereby, the public may obtain information, make submittals or requests, or obtain decisions;

(B) statements of the general course and method by which its functions are channeled and determined, including the nature and requirements of all formal and informal procedures available;

(C) rules of procedure, descriptions of forms available or the places at which forms may be obtained, and instructions as to the scope and contents of all papers, reports, or examinations;

(D) substantive rules of general applicability adopted as authorized by law, and statements of general policy or interpretations of general applicability formulated and adopted by the agency; and

(E) each amendment, revision, or repeal of the foregoing.

Except to the extent that a person has actual and timely notice of the terms thereof, a person may not in any manner be required to resort to, or be adversely affected by, a matter required to be published in the Federal Register and not so published. For the purpose of this paragraph, matter reasonably available to the class of

persons affected thereby is deemed published in the Federal Register when incorporated by reference therein with the approval of the Director of the Federal Register.

(2) Each agency, in accordance with published rules, shall make available for public inspection and copying—

(A) final opinions, including concurring and dissenting opinions, as well as orders, made in the adjudication of cases;

(B) those statements of policy and interpretations which have been adopted by the agency and are not published in the Federal Register; and

(C) administrative staff manuals and instructions to staff that affect a member of the public;

unless the materials are promptly published and copies offered for sale. To the extent required to prevent a clearly unwarranted invasion of personal privacy, an agency may delete identifying details when it makes available or publishes an opinion, statement of policy, interpretation, or staff manual or instruction. However, in each case the justification for the deletion shall be explained fully in writing. Each agency also shall maintain and make available for public inspection and copying a current index providing identifying information for the public as to any matter issued, adopted, or promulgated after July 4, 1967, and required by this paragraph to be made available or published. A final order, opinion, statement of policy, interpretation, or staff manual or instruction that affects a member of the public may be relied on, used, or cited as precedent by an agency against a party other than an agency only if—

(i) it has been indexed and either made available or published as provided by this paragraph; or

(ii) the party has actual and timely notice of the terms thereof.

(3) Except with respect to the records made available under paragraphs (1) and (2) of this subsection, each agency, on request for identifiable records made in accordance with published rules stating the time, place, fees to the extent authorized by statute, and procedure to be followed, shall make the records promptly available to any person. On complaint, the district court of the United States in the district in which the complainant resides, or has his principal place of business, or in which the agency records are situated, has jurisdiction to enjoin the agency from withholding agency records and to order the production of any agency records improperly withheld from the complainant. In such a case the court shall determine the matter de novo and the burden is on the agency to sustain its action. In the event of noncompliance with the order of the court, the district court may punish for contempt the responsible employee, and in the case of a uniformed service, the responsible member. Except as to causes the court considers of greater importance, proceedings before the district court, as authorized by this paragraph, take precedence on the docket over all other causes and shall be assigned for hearing and trial at the earliest practicable date and expedited in every way.

(4) Each agency having more than one member shall maintain and make available for public inspection a record of the final votes of each member in every agency proceeding.

(b) This section does not apply to matters that are—

(1) specifically required by Executive order to be kept secret in the interest of the national defense or foreign policy;

(2) related solely to the internal personnel rules and practices of an agency;

(3) specifically exempted from disclosure by statute;

(4) trade secrets and commercial or financial information obtained from a person and privileged or confidential;

(5) inter-agency or intra-agency memorandums or letters which would not be available by law to a party other than an agency in litigation with the agency;

(6) personnel and medical files and similar files the disclosure of which would constitute a clearly unwarranted invasion of personal privacy;

(7) investigatory files compiled for law enforcement purposes except to the extent available by law to a party other than an agency;

(8) contained in or related to examination, operating, or condition reports prepared by, on behalf of, or for the use of an agency responsible for the regulation or supervision of financial institutions; or

(9) geological and geophysical information and data, including maps, concerning wells.

(c) This section does not authorize withholding of information or limit the availability of records to the public, except as specifically stated in this section. This section is not authority to withhold information from Congress.

PLAINTIFF'S STATEMENT OF MATERIAL FACTS AS TO WHICH THERE IS NO GENUINE ISSUE PURSUANT TO LOCAL RULE 9(h)

FILED JUNE 19, 1973

1. This action arises under 5 U.S.C. 552. Jurisdiction and venue are properly laid in this Court.

2. Defendant controls some 170 to 175 bound volumes of decisions within the scope of the decisions defined by 5 U.S.C. 552(a)(2)(A), (B) and (C) composed during the years 1853 to 1954, at least some of which include individual indices in the front of each volume.

3. These bound volumes of manuscript decisions constitute a class or category of documents identified as such by defendant and the Patent Office over which he is chief administrator, as shown *inter alia* by the June 15, 1972 decision of the Court of Appeals for the District of Columbia in this case.

4. Defendant also controls a number of docket cards of the Patent Office Board of Appeals, the Patent Office Board of Patent Interferences, and for individual patent applications whether pending, abandoned, or "allowed". These docket cards contain a full record of the proceedings in each appeal, interference, or application to which they pertain, including a record of each decision falling within the scope of 5 U.S.C. 552(a)(2)(A), (B), or (C), if any, rendered in connection with that appeal, interference, or application. It is therefore possible to determine from the docket cards the identity of each decision within the scope of 5 U.S.C. 552(a)(2)(A), (B) or (C) that may be contained in the associated appeal, interference, or application file.

5. Each presently existing patent application is maintained in the Patent Office in one or more file wrapper jackets. Each file wrapper jacket lists in date order

each of the papers contained in the file including each and every decision responding to the definitions contained in 5 U.S.C. 552(a)(2)(A), (B), or (C) if any, that may be contained in that application file. It is accordingly possible to determine from the file wrapper jacket index listing the identity of each decision within the scope of 552(a)(2)(A), (B), or (C) that may be contained in that application file.

6. The docket index cards have been previously identified by defendant as a group.

7. Defendant has also acknowledged that the outer jacket of the file of each application carries the same chronology of events as is entered on the docket cards and has thereby identified the file wrapper jacket index lists as a category of documents existent within the Patent Office.